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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,470	04/02/2001	David Lawrence	3499-107	1341

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EXAMINER	
MOONEYHAM, JANICE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,470	LAWRENCE, DAVID	
	Examiner	Art Unit	
	Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-9,11-22 and 24-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-9,11-22 and 24-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 16, 2004, wherein:

Claims 1-2, 4-9, 11-22, and 24-27 are currently pending in this application;

Claims 3, 10, and 23 have been cancelled;

Claims 1-2, 4-6, 9, 11, 13-14, 16 and 20-22 have been amended;

Claim 27 has been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2004 has been entered.

Response to Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4-9, 11-22, and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following terms are unclear to the Examiner and the Examiner is unable to find the terms described in the specification is such a way as to enable one skilled in the art to make or use the invention:

Digital information, structuring with a processor the information received relating to details of the legal action, the predetermined criteria, the scaled numeric value or scaled alphanumeric value indicative of an amount of risk associated with the legal action, how the scaled numeric value or scaled alphanumeric value is based upon a portion of the structured information, how a suggested action is generated responsive to the values, what is an aggregate level of risk.

It is unclear how the scaled numeric value or a scaled alphanumeric value indicative of an amount of risk is generated.

Applicant states on pages 10-11 of the response that the scaled numeric or alphanumeric value is calculated by:

a) assigning a numerical value representative of the risk associated with a particular piece of information (p. 12 lines 2-3),.

b) assigning a weight to a risk assessment factor to which the information is assigned (p. 12 lines 8-10); and

c) multiplying the numerical value times the weight to obtain a risk factor (p 13 lines 10-13)

d) summing up multiple risk factors to obtain a risk quotient (scale. alphanumerical value) (p. 13 lines 13-14).

The specification therefore explicitly states one exemplary way to implement the invent, which includes multiplying (an assigned numerical value representative of risk associated with a piece of information) x (a numerical weight of a risk assessment factor to which the information is assigned) and summing up the results for multiple pieces of information to obtain a risk quotient (scaled numerical or alphanumerical value).

The calculation leaves only a subjective or general description of how to make the calculation. The is no detailed or concrete, full, concise and exact written description of how one would quantify and calculate the scaled numeric or alphanumeric value. With respect to subjective information entered by a person this does not produce a repeatable or concrete result as required by the statue.

The Examiner is still unclear what the numerical values are, how the numerical value is assigned and how a weight is assigned to a risk assessment factor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-9, 11-22, and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states that wherein the scaled numeric value or scaled alphanumeric value is based upon a *portion* of the structured information.

On page 14 of the specification, the applicant identifies the risk quotient as being typically a scaled numerical score based upon values for weighted criteria. How is the weighted criteria determined?

How is the structuring with a processor the information received according to risk quotient criteria done?

How is the generating a risk quotient with a computer processor operatively performed?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1-2, 4-9, 11-22, and 24-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The claimed invention does not produce a concrete result. The invention as claimed is not repeatable and cannot be implemented without undue experimentation.

MPEP 2106 II A states as follows:

> A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant admits on page 10 of applicant's response that the present invention is free to generate a value via objective or ***subjective*** means. Applicant states on page 10 that:

> The present invention is not limited to any one method or algorithm for the generation of such a scaled value. Many techniques and methods can be adapted for the generation of a scaled value based upon the information relating to legal action. Applicant respectfully suggests that the present invention is not limited to any one algorithm or method for ascertaining the scaled numeric or alphanumeric value, and that generating such a person practicing the present invention is free to generate a value via objective or ***subjective*** means.

Applicant states on page 11 of the response that the "example on page 12, lines 15-27 specifically details that a risk assessment can be ***subjective*** to the client using the present invention, as can be a numerical value representative of the risk associated with a particular piece of information. Applicant further states that a risk assessment fact can be anything that is important to the client and relates to the client's status as party to a litigation or an amicus curiae.

Many subjective interpretive criteria are involved in coming up with the end result and it is not clear that the end result is predictive or actually useful. There is no necessary list of essential elements or questions identified to produce a concrete result. The specification provides very little usable clear guidance as to how to objectively make the determination that is produced in the report.

Thus, the applicant's invention is a process that consists solely of the manipulation of an abstract idea and therefore is not concrete.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-9, 11-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al. (US 5,875, 431) (hereinafter referred to as Heckman) in view of Halligan et al (2002/0077941) (hereinafter referred to as Halligan).

Referring to Claims 1, 16, and 20-22:

Heckman discloses a computer-implemented method and system and program code for performing the method of managing risk related to a legal action (legal strategic analysis planning and evaluation), the method, system, and program code comprising:

a computer server accessible with a network access device via a communications network and software stored on the server (Fig. 2);

receiving digital information into the computer storage identifying a person's status as at least one of a party to a legal action and an amicus curiae of the court in a pending legal action (Fig. 1-2, 3 (33,36), and 4, col. 8, lines 38-52, col. 10, line 65 thru col. 11, lines 17);

receiving digital information into the computer storage relating to details of the legal action (Figs. 1, 2, 3 (33, 34), Fig. 4 (Legal and Factual Issues); and

generating a report (Fig. 5-2 (68, 69)).

Heckman does not discloses

structuring with a processor the information received relating to details of the

legal action according to predetermined criteria;

generating a scaled numeric value or a scaled alphanumeric value indicative of an amount of risk associated with the legal action with a computer

processor operatively attached to the computer storage, wherein the scaled numeric value or scaled alphanumeric value is based upon a portion of the structured information related to a legal action and the gathered data; and

generating a report comprising the scaled numeric or alpha numeric value and the portion of the structured information upon which the scaled numeric or alphanumeric number is based.

However, Halligan discloses:

structuring with a processor the information received relating to details of the

legal action according to predetermined criteria (Fig. 4, page 2 [0020-0023]page 6 [0094], page 7 [0096] (generally accepted legal criteria);

generating a scaled numeric value or a scaled alphanumeric value indicative of an amount of risk associated with the legal action with a computer ((page 6 [0095] and page 7 [0096-0098])

processor operatively attached to the computer storage, wherein the scaled numeric value or scaled alphanumeric value is based upon a portion of the structured information related to a legal action and the gathered data (((page 6 [0095] and page 7 [0096-0098]); and

generating a report comprising the scaled numeric or alpha numeric value and the portion of the structured information upon which the scaled numeric or alphanumeric number is based (Figs. 3-4, 6 – Report Outliers, page 3 [0034]).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Heckman the teachings of Halligan so that an evaluation can be done to determine whether the information (trade secret) is likely to meet the tests applied by the courts and

comparing the results with predetermined threshold values may be used to provide an objective measure of whether the information (trade secret) is defendable).. .

Referring to Claim 2:

Both Halligan and Heckman further discloses a method additionally comprising the step of generating a suggested action responsive to the scaled numeric value or a scaled alphanumeric value (Halligan - page 7 [0096-0099] (determination made) and Heckman (col. 5, lines 64-67, col. 6, lines 13-17, lines 45-48, col. 19 – BEST MODE, Fig. 5-1 (62).

Referring to Claim 4:

Both Halligan and Heckman further discloses a method wherein the report additionally comprises actions taken responsive to the scaled numeric value or a scaled alphanumeric value (Halligan - page 7 [0098]) and (Heckman Fig. 5-1 (62) 963), col. 19 thru 26 BEST MODE).

Referring to Claim 5:

Both Halligan and Heckman disclose a method wherein the suggested action is additionally responsive to the information received related to details of the legal action (Halligan (page 2 [0020-0023],page 3 [0034], page 6 [0095], page 7 [0096-0098]) and (Heckman Figs. 3 - 5-2)

Referring to Claim 6:

Both Halligan and Heckman disclose a method wherein the suggested action is directed towards reducing risk related to a legal action (Halligan – page 1 [0009], page 2 [0020}) and Heckman – col. 6, lines 9-23).

Referring to Claims 7-9:

Heckman discloses a strategic planning system and process with the ability to provide the "best" legal strategic plan (col. 6, lines 8-23, 45-64)) which would encompass wherein the suggested action comprises commencing a litigation, wherein the suggested action comprises entering arbitration, wherein the suggested legal action comprises settling a legal action.

Referring to Claims 11-12:

Heckman further discloses a method wherein the information received related to details of the legal action comprises venue for a legal action (col. 8, lines 21-36 (Venue), col. 16, lines 59-60, col. 15, lines 21-22, col. 16, lines 58-63)) and a method wherein the information received is gathered electronically (col. 12, lines 49-54, fig. 2).

Referring to Claim 13 and 14:

Both Heckman and Halligan disclose a method additionally comprising the step of aggregating scaled numerical or alphanumerical values relating to the person (defendants Heckman col. 8, lines 38-63) (trade secret –Halligan) and assessing an aggregate level of risk related to the actions (Heckman Fig. 1-2, Fig. 3 (33 – case specific data, (34, 35, 37, 38), Fig. 4, legal and factual issues, nature of case) Figs. 5-1 – 5-2) and Halligan (pages 2-3 {0020-0034] and a method additionally comprising the step of calculating an average scaled numeric value or a scaled alphanumeric value associated with the person or trade secret (Heckman – (Fig. 3) set values to create forecast (35), measure objectives, tasks, costs (38), col. 6, lines 45-56, col. 7, lines 4-12) col. 19-26 BEST MODE) and Halligan (page 2 [0020-0023], page 3 [0026-0034], page 7 [0096-0099]).

Referring to Claim 15:

Heckman discloses a method of claim 1 wherein the legal action comprises a class action suit (Fig. 4, Nature of the Case), page 8 lines 37-52).

Referring to Claims 17-19:

Halligan discloses a system wherein the information is received via an electronic feed, a personal computer or a wireless handheld device (pages 3-4 [0053-0066], page 4 [0080]).

Referring to Claims 24-27:

The fact that the person involved in a legal action comprises at least one of a legal person or natural person, or a combination of both, wherein a legal person additionally comprises a governmental entity, wherein the suggested action comprises appearing as an amicus curiae of the court in a litigation, and wherein the risk comprises legal, regulatory, financial and reputational exposure is determined to be nonfunctional descriptive data which is not functionally involved in the steps recited. The steps to the invention would be performed the same regardless of this data. Thus, this descriptive material will not distinguish the claimed invention form the prior art in terms of patentablility, see *In re Gulack,* 703 f. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *in re Lowry,* 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Response to Arguments

7. Applicant's arguments filed September 16, 2004 have been fully considered but they are not persuasive.

The applicant argues against the Examiner's rejection under 35 USC Section 112 , first paragraph for failing to comply with the enablement requirement. However, on page 10 of the response, applicant states the following:

> The present invention is not limited to any one method or algorithm for the generation of a scaled value. Many techniques and methods can be adapted for the generation of a scaled value based upon the information relating to legal action. ***Applicant respectfully suggests that e present invention is not limited to any one algorithm or method for ascertaining the scaled numeric or alphanumeric value, and that generating such a person practicing the present invention is free to generate a value via objective or subjective means.***

However, the following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, **in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same** and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As the claim language and specification are written, the disclosure is entirely subjective and incomplete and only provides a general description of old and well known approaches to common analysis of risk. The applicant has not provides a specific set of steps with a specific

set of detailed criteria or values or algorithms or formulas. This is further evidenced by the applicant's admission on page 11 wherein the applicant states that:

> In addition, at p. 12 lines 15-27, the specification lays out a specific example of how a scaled numerical or alphanumerical value may be calculated. The example on p. 12 lines 15-27 specifically details that a risk assessment weight can be ***subjective*** to the client using the present invention, as can be a numerical value representative of the risk associated with a particular piece of information. A ***risk assessment factor can be anything that is important to the client and relates to the client's status*** as party to a litigation or an amicus ctzriae.

As for the applicant's arguments to the rejection under 35 USC Section 103, the applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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